

1 REMARKS

2 Status of the Claims

3 Claims 1-29 and 75-91 are pending in the present application, Claims 30-74 having been
4 canceled (in response to a restriction requirement), and new Claims 75-91 having been added in the
5 present amendment. Claim 5 has been amended to correct a grammatical error.

6 Summary of Telephone Interview with the Examiner

7 On June 28, 2006, applicants' attorney (Michael C. King, Registration No. 44,832) contacted
8 Examiner Stephenson via telephone to discuss the current rejection of Claims 21, 22, and 24-28 under
9 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6,237,701 (hereafter referred to as the '701 patent).
10 Applicants' attorney raised the issue that independent Claim 21 specifically recites a tool that
11 includes a first member and a second member, which reciprocate back and forth, where the second
12 member is disposed *within* the first member, while the '701 patent discloses a tool in which the
13 second member is *not* disposed within the first member.

14 The Examiner indicated that upon further reflection, it did appear that the initial interpretation
15 of the first member was overly broad, and he agreed that a second member disposed within a first
16 member distinguishes over the configuration disclosed by the '701 patent. The Examiner noted that
17 because a response was required to cancel non-elected Claims 30-74, applicants should provide a
18 written summary of the above argument for traversing this rejection in the response. The Examiner
19 further indicated that the rejected claims would likely be allowable, unless a review of additional art
20 provided a basis for a subsequent rejection.

21 Applicants' attorney would like to again thank Examiner Stephenson for taking the time to discuss the
22 issues noted above during the telephone interview, so as to substantially advance the prosecution of the present
23 application.

24 Claim rejections under 35 U.S.C. § 102

25 The Examiner has rejected Claims 21, 22, and 24-28 as being anticipated by an earlier
26 commonly assigned patent, that had previously been filed by the applicant, i.e., the '701 patent. The
27 Examiner asserts that the '701 patent discloses an equivalent structure, i.e., a structure in which a first
28 and second member reciprocate back and forth, where the second member is disposed within the first
29 member. Applicants respectfully disagree for the following reason.

As noted above in the summary of the telephone interview, the structure disclosed by the '701 patent does not include a second member that is disposed *within* the first member. It is true that the '701 patent discloses a tool having a first member and a second member that reciprocate. However, as taught in the '701 patent, the second member is NOT disposed *within* the first member.

Applicants' claims currently recite that the first member cycles between an open position and a closed position, such that when in the closed position, the first member at least partially interrupts a flow of pressurized fluid through an outlet port. Referring to FIGURE 3 of the '701 patent, poppet valve 58 cycles between an open position and a closed position, such that when in the closed position, the poppet valve at least partially interrupts a flow of pressurized fluid through an outlet port. Thus, poppet valve 58 is functionally equivalent to the recited first member.

In the present claims, applicants' second member reciprocates back and forth, thereby controlling actuation of the first member, but *must be disposed within the first member*. Once again referring to FIGURE 3 of the '701 patent, pilot valve 41 reciprocates back and forth, thereby controlling actuation of poppet valve 58. However, pilot valve 41 is not disposed within poppet valve 58. The Examiner's articulation of the rejection makes it clear that the Examiner initially considered manifold 82 and poppet valve 58 to be a single entity. Applicants respectfully submit that such an interpretation is not justified. Manifold 82 is not part of poppet valve 58. Manifold 82 is stationary, while poppet valve 58 reciprocates back and forth. Pilot valve 41 and poppet valve 58 are disposed within the same housing, but the pilot valve is not disposed within the poppet valve in the configuration taught by the '701 patent.

Nor is there any evidence that one of ordinary skill in the art would have been led to modify the structure disclosed in the '701 patent to achieve a structure equivalent to that recited by applicants' claims. Thus, Claim 21 patentably distinguishes over the cited art. It is well recognized that dependent claims are patentable for at least the same reasons as the claims from which they depend. Accordingly, the rejection of Claims 21, 22, and 24-28 as being anticipated by the '701 patent should be withdrawn.

Patentability of the Newly Added Claims

Applicants previously traversed the restriction requirement, by noting that the method of Claim 30 must be implemented using a valve that cycles between a first position and a second position, and that Claims 1-29 define a valve that cycles between a first position and a second

1 position. The Examiner upheld the restriction requirement, on his belief that the method of Claim 30
2 does not require the second member of the valve to be disposed within the first member of the valve.
3 Applicants have added new method claims, substantially based on Claim 30, but which are consistent
4 with the structure in the elected claims (i.e., which recite a valve having a first member and a second
5 member that reciprocate back and forth, where the second member is disposed within the first
6 member). Thus, the newly added claims patentably distinguish over the cited art for substantially the
7 same reasons as the claims that the Examiner has already allowed.

8 New Claim 75 is based on original Claim 30, with the additional recitation of a valve having a
9 first member and a second member that reciprocate, where the second member is disposed within the
10 first member. Thus, new Claim 75 is entirely consistent with the elected invention, and simply
11 represents the presentation of a method claim that substantially corresponds to the elected (and
12 allowed) apparatus claims.

13 New Claim 76 corresponds to the subject matter of Claim 29 (a claim to which the Examiner
14 had objected), written as a method claim.

15 New Claim 77 corresponds to the subject matter of allowed Claim 2, written as a method
16 claim.

17 New Claim 78 corresponds to the subject matter of allowed Claim 3, written as a method
18 claim.

19 New Claim 79 corresponds to the subject matter of allowed Claim 4, written as a method
20 claim.

21 New Claim 80 corresponds to the subject matter of allowed Claim 5, written as a method
22 claim.

23 New Claim 81 corresponds to the subject matter of allowed Claim 6, written as a method
24 claim.

25 New Claim 82 corresponds to the subject matter of allowed Claim 7, written as a method
26 claim.

27 New Claim 83 corresponds to the subject matter of allowed Claim 11, written as a method
28 claim.

29 New Claim 84 corresponds to the subject matter of allowed Claim 14, written as a method
30 claim.

1 New Claim 85 corresponds to the subject matter of allowed Claim 15, written as a method
2 claim.

3 New Claim 86 corresponds to the subject matter of allowed Claim 17, written as a method
4 claim.

5 New Claim 87 corresponds to the subject matter of allowed Claim 18, written as a method
6 claim.

7 New Claim 88 corresponds to the subject matter of allowed Claim 19, written as a method
8 claim.

9 New Claim 89 corresponds to the subject matter of allowed Claim 20, written as a method
10 claim.

11 New Claim 90 substantially corresponds to the subject matter of allowed Claim 21, written as
12 a method claim. Note that as discussed above, Claim 21 is clearly distinguishable over the cited art.

13 New Claim 91 substantially corresponds to the subject matter of Claim 1, written as a method
14 claim.

15 Accordingly, all of the claims now pending define patentable subject matter that is neither
16 anticipated nor obvious in view of the prior art cited. The Examiner is thus requested to issue the
17 present patent in view of the amendments and the remarks submitted above. If there are any questions
18 that might be addressed by a telephone interview, the Examiner is invited to telephone the undersigned
19 attorney, at the number listed below.

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21 Respectfully submitted,

22
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